UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,064	06/15/2001	Adrian C.H. Scott	APPLP001	1705

29141   7590   12/02/2005

SAWYER LAW GROUP LLP
P O BOX 51418
PALO ALTO, CA 94303

EXAMINER
PATEL, HARESH N

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
09/883,064</td><td colspan="2">Applicant(s)
SCOTT ET AL.</td></tr>
<tr><td>Examiner
Haresh Patel</td><td>Art Unit
2154</td><td></td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,6,37-39,41,42,73-75,77 and 78* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,6,37-39,41,42,73-75,77 and 78* is/are rejected.

7)☒ Claim(s) *3,39 and 75* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☒ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. *11222005*.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-3, 5-6, 37-39, 41-42, 73-75 and 77-78 are subject to examination. Claims 4, 7-

8, 9-36, 40, 43-72, 76 and 79-87 are cancelled.

Response to Arguments

2.   Applicant's arguments filed 9/12/2005, pages 12-17 have been fully considered but they

are not persuasive. Therefore, rejection of claims 1-3, 5-6, 37-39, 41-42, 73-75 and 77-78 is

maintained.

Applicant argues (1), "Since, page 9 of the Specification states "Keyed SHA1" is an

example of fingerprinting or hash code algorithm that may be used in conjunction with the

technique of the present invention, as described in RFC 2841 (attached to the application as

Appendix B). RFC 2841 specifies a newer version of SHA than that described in (FIPS-180),

which was flawed. Hence, the name Keyed SHA1, Therefore, the claimed "Secure Hash

Algorithm" of claims 3, 39, and 75 is "SHA1" and not SHA".

The examiner respectfully disagrees in response to applicant's arguments. Since, claims

3, 39, and 75 clearly state, "Secure Hash Algorithm" and not "Secure Hash Algorithm 1",

examiner considered it as "Secure Hash Algorithm" for examination (see office action dated

6/3/2005). As per applicant's assertions, the claims do not include, "Keyed SHA1 to specify a

newer version of SHA than that described in (FIPS-180)". Hence, claims 3, 39, and 75 are

rejected considering "Secure Hash Algorithm" and the rejection is maintained.

Further, for clarification, claims 3, 39, and 75 are rejected under Farber et al., 6,415,280

(Hereinafter Farber) in view of "Official Notice". As per office action dated 6/3/2005, Juopperi,

6,225,888, col., 4, lines 30 – 35, discloses that SHA stands for <u>Secure Hash Algorithm.</u> In order

to demonstrate that even SHA1 is also well known in the art. The reference, Markandey et al.,

U.S. Publication 2002/0101989 discloses Secure Hash Algorithm-1, paragraph 41, page 3.

Another reference, RFC 3174, page 1, also discloses the well-known Secure Hash Algorithm-1,

i.e., SHA1. Therefore, the rejection is maintained.

Applicant argues (2), "the cited reference do not disclose, teach, or suggest the

applicant's claimed, <u>each</u> <u>shared</u> <u>file</u> in the network … to identify <u>identical files</u> stored in the

peer-to-peer network which have <u>different</u> file names and/or other <u>metadata descriptors</u> … an

<u>automated process</u> to <u>retrieve</u> the <u>desired content,</u> … a <u>user elect to retrieve</u> a desired file …

stored at <u>remote locations</u> in the peer-to-peer network, … to <u>automatically select</u> one or more

<u>remote locations</u> for retrieving the <u>desired file, multiple copies</u> of the <u>same file</u> to be stored in the

network … with the <u>same fingerprint ID</u>.

The examiner respectfully disagrees in response to applicant's arguments. In response to

applicant's argument that the references fail to show certain features of applicant's invention, it is

noted that the features upon which applicant relies, "<u>each</u> <u>shared</u> <u>file</u> in the network … to

identify <u>identical files</u> stored in the peer-to-peer network which have <u>different</u> file names and/or

other <u>metadata descriptors</u> … an <u>automated process</u> to <u>retrieve</u> the <u>desired content,</u> … a <u>user</u>

<u>elect to retrieve</u> a desired file … stored at <u>remote locations</u> in the peer-to-peer network, … to

<u>automatically select</u> one or more <u>remote locations</u> for retrieving the <u>desired file, multiple copies</u>

of the <u>same file</u> to be stored in the network … with the <u>same fingerprint ID</u>", are not recited in

the rejected claim(s). Although the claims are interpreted in light of the specification, limitations

from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). The First inquiry must be into exactly what the <u>claims</u> define.

See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970). For example, the fingerprint ID is <u>not same</u>

in the claimed invention, see claim 1, line 9, contains "a first fingerprint ID", line 16, contains

another, "an identical first <u>fingerprint ID</u> (without "the" or "said")", line 17, contains, another

"first <u>fingerprint ID</u> (without "the" or "said")", line 19, contains, another "first <u>fingerprint ID</u>

(without "the" or "said")", line 21, contains, another "the first <u>unique</u> <u>fingerprint ID</u> (not first

fingerprint ID)".

What is claimed is, see claims 1, 37 and 73, which is related to the above arguments, "the

first information file is stored at a first peer device, and wherein the first information file has an

associated first filename, storing the first filename and first fingerprint ID at the first peer device,

and identifying both the first and the second information file using the first unique fingerprint ID.

Farber discloses the limitations, "the first information file (e.g., col., 6, lines 46 – 65) is stored at

a first peer device (e.g., col., 7, line 65 – col., 8, lines 14), and wherein the first information file

(e.g., col., 6, lines 46 – 65) has an associated first filename (e.g., col., 8., lines 24 – 39, col., 12,

lines 19 - 36), storing the first filename (e.g., col., 12, lines 19 – 36) and first fingerprint ID at the

first peer device (e.g., col., 6, lines 6 – 12, col., 8, lines 30 – 39, col., 17, lines 18 - 56), and

identifying both the first and the second information file (e.g., col., 8., lines 24 – 39, col., 12,

lines 19 - 36) using the first unique fingerprint ID (e.g., col., 35, lines 52 – 64) as claimed.

Further, Farber also discloses the concept of the same fingerprint ID (e.g., col., 6, lines 6 – 12,

col., 8, lines 30 – 39, col., 17, lines 18 - 56). Also, the specification of the application, page 24,

lines 9 – 24, clearly states, Although several preferred embodiments of this invention have been

described in detail herein with reference to the accompanying drawings, it is to be understood

that the invention is not limited to these precise embodiments, and that various changes and

modifications may be effected therein by one skilled in the art without departing from the scope

of spirit of the invention as defined in the appended claims". Since, applicant's claims contain

broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed

subject matter. Therefore, the rejection is maintained.

Applicant argues (3), "the cited reference teaches away from storing multiple copies of

the same file". The examiner respectfully disagrees in response to applicant's arguments.

Contrary to the applicant's assertions, Farber not only discloses that single copy of the same file

is stored, col., 14, lines 29-35, col., 33, lines 7-13, but also discloses the well-known concept of

storing multiple copies of the same file, for example, backups or mirror copies including multiple

copies of the same file, col., 14, lines 29-35, col., 33, lines 7-13. Since, Farber also discloses the

storing of multiple copies of the same file, the rejection is maintained.

Claim Objections

3.   Claims 3, 39 and 75 are objected to because of the following informalities:

Claims 3, 39 and 75 mention, "Secure Hash Algorithm (SHA1)", which is incorrect. It

should be Secure Hash Algorithm (SHA)" (see office action dated 6/3/05).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter, which the applicant regards as his invention.

4.   Claims 1, 37 and 73 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention (see office action dated 6/3/05).

Claims 1, 37 and 73 recite the limitations, "the content of the first information file".

Since, multiple "content" (content from selected information files, content identical to the first

information file) exist in the claim, it is not clear which "content" is referred by the limitations in

the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1, 2, 5, 6, 37, 38, 41-42, 73, 74, 77 and 78 are rejected under 35 U.S.C. 102(e) as

being anticipated by Farber et al., 6,415,280 (Hereinafter Farber).

7.   As per claim 1, Farber clearly discloses a method (e.g., col., 3, lines 26 – 44) for

accessing information in a peer-to-peer network (e.g., col., 5, lines 13 – 24), the peer-to-peer

network including a plurality of peer devices (e.g., col., 5, lines 26 – 34) and a database system

(e.g., col., 5, lines 26 – 34) accessible by at least a portion of the peer devices (e.g., col., 5, lines

26 – 34), each of the peer devices (e.g., col., 5, lines 26 – 34) being configured to store

information files (e.g., col., 8, lines 41 – 57), and further being configured to share content (e.g.,

col., 8, lines 3 – 23) from selected information files (e.g., col., 8, lines 41 – 57) with at least a

portion of the other peer devices (e.g., col., 5, lines 26 – 34) in the network (e.g., col., 5, lines 13

– 24), the method comprising:

selecting a first information file (e.g., col., 6, lines 46 – 65);

generating (e.g., col., 6, lines 28 – 46), using fingerprinting algorithm (e.g., col., 12, lines

45 – 67), a first fingerprint ID (e.g., col., 9, lines 35 – 64) relating to the content of the first

information file (e.g., col., 8, lines 41 – 58);

the first information file (e.g., col., 6, lines 46 – 65) is stored at a first peer device (e.g.,

col., 7, line 65 – col., 8, lines 14), and wherein the first information file (e.g., col., 6, lines 46 –

65) has an associated first filename (e.g., col., 8., lines 24 – 39, col., 12, lines 19 - 36),

storing the first filename (e.g., col., 12, lines 19 – 36) and first fingerprint ID at the first

peer device (e.g., col., 6, lines 6 – 12, col., 8, lines 30 – 39, col., 17, lines 18 - 56),

selecting a second information file (e.g., col., 12, lines 19 – 36) having content identical

(e.g., col., 3, lines 12 – 19) to the first information file (e.g., col., 12, lines 19 – 36); applying the

fingerprinting algorithm (e.g., col., 12, lines 60 – 65) to the content of the second information file

(e.g., col., 12, lines 19 – 36) to thereby generate an identical (e.g., col., 35, lines 52 – 64) first

fingerprint ID (e.g., col., 6, lines 6 – 12, col., 8, lines 30 – 39, col., 17, lines 18 - 56) to that of the

first information file (e.g., col., 8., lines 24 – 39, col., 12, lines 19 - 36); and identifying both the

first and the second information file (e.g., col., 8., lines 24 – 39, col., 12, lines 19 - 36) using the

first unique fingerprint ID (e.g., col., 35, lines 52 – 64),

the first information file (e.g., col., 8., lines 24 – 39, col., 12, lines 19 - 36) is stored at a

first peer device (e.g., col., 7, line 62 – col., 8, line 17), and has a first associated filename (e.g.,

col., 12, lines 19 – 36), and wherein the second information file (e.g., col., 35, lines 43 – 64) is

stored at a second peer device (e.g., col., 36, lines 1 – 14), and has a second associated filename

(e.g., col., 8., lines 24 – 39, col., 12, lines 19 – 36),

storing the first <u>associated</u> filename (e.g., col., 12, lines 19 – 36) and first fingerprint ID

(e.g., col., 6, lines 6 – 12, col., 8, lines 30 – 39, col., 17, lines 18 - 56) <u>associated</u> with the first

information file (e.g., col., 8., lines 24 – 39, col., 12, lines 19 - 36) in the database system (e.g.,

col., 7, line 62 – col., 8, line 17) and storing the second <u>associated</u> filename (e.g., col., 12, lines

19 – 36) and first fingerprint ID (e.g., col., 6, lines 6 – 12, col., 8, lines 30 – 39, col., 17, lines 18

- 56) <u>associated</u> with the second information file (e.g., col., 12, lines 19 – 36) in the database

system (e.g., col., 7, line 62 – col., 8, line 17).

8.   As per claim 37, Farber discloses the claimed limitations as rejected above. Faber also

discloses a system (e.g., col., 7, line 65 – col., 8, lines 14) <u>for</u> accessing information in a peer-to-

peer network (e.g., col., 5, lines 13 – 24), and the system comprising at least one CPU (e.g., col.,

5, lines 26 – 34), memory (e.g., col., 5, lines 26 – 34), at least one interface (e.g., col., 5, lines 26

– 34) <u>for</u> communicating with other devices (e.g., col., 5, lines 26 – 34, col., 7, line 65 – col., 8,

lines 14).

9.   As per claim 73, Farber discloses the claimed limitations as rejected above. Faber also

discloses a computer program product (e.g., col., 7, line 65 – col., 8, lines 14) for accessing

information in a peer-to-peer network (e.g., col., 5, lines 13 – 24), and a computer usable

medium having computer readable code embodied therein (e.g., col., 5, lines 26 – 34, col., 7, line

65 – col., 8, lines 14).

10.   As per claims 2, 38, 74, Farber discloses the claimed limitations as rejected above. Faber

also discloses the fingerprinting algorithm corresponds to an MD5 Message-Digest algorithm

(e.g., col., 12, lines 60 – 65).

11.   As per claims 5, 41, 77, Farber discloses the claimed limitations as rejected above. Faber

also discloses transmitting (e.g., col., 23, lines 16 – 41) the first filename and the first fingerprint

ID to the database system for storage therein (e.g., col., 7, line 62 – col., 8, line 17).

12.   As per claims 6, 42, 78, Farber discloses the claimed limitations as rejected above. Faber

also discloses the database system corresponds to a remote database system (e.g., col., 7, line 62

– col., 8, line 17).

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14.   Claims 3, 39, 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farber in view of "Official Notice".

15.   As per claims 3, 39, 75, Farber discloses the claimed limitations rejected under claims 1, 37 and 73. Faber also discloses the SHA fingerprinting algorithm (e.g., col., 12, lines 60 – 65). However, Farber does not specifically mention that SHA stands for Secure Hash Algorithm.

"Official Notice" is taken that both the concept and advantages of providing Secure Hash Algorithm is well known and expected in the art. For example, Juopperi, 6,225,888, col., 4, lines 30 – 35, discloses that SHA stands for Secure Hash Algorithm. Markandey et al., U.S. Publication 2002/0101989 discloses these limitations, paragraph 41, page 3. RFC 3174, also discloses theses limitations, page 1.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Secure Hash Algorithm with the teachings of Farber in order to facilitate usage of Secure Hash Algorithm because the algorithm would help hashing the information. The secure hashing would enhance reliability of the system.

Conclusion

16.   The prior art made of record (forms PTO-892 and applicant provided IDS cited arts) and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the

organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Haresh Patel

November 22, 2005